

**IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF DELAWARE**

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ST. CLAIR INTELLECTUAL PROPERTY  
CONSULTANTS, INC.,

Plaintiff,

Civil Action No. 09-804 (JJF)

**JURY TRIAL DEMANDED**

v.

APPLE INC.,

Defendant.

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**PLAINTIFF ST. CLAIR INTELLECTUAL PROPERTY CONSULTANTS, INC.'S  
REPLY TO APPLE INC.'S COUNTERCLAIMS**

Plaintiff St. Clair Intellectual Property Consultants, Inc. ("St. Clair") for its Reply to the Counterclaims asserted in Defendant Apple Inc.'s ("Apple") Answer and Counterclaims to St. Clair Intellectual Property Consultants, Inc.'s First Amended Complaint for Patent Infringement (D.I. 15), states and alleges as follows:

**GENERAL DENIAL**

Unless specifically admitted below, St. Clair denies each and every allegation set forth in Apple's Counterclaims.

**RESPONSE TO SPECIFIC ALLEGATIONS**

In reply to the separately numbered paragraphs of Apple's Counterclaims, St. Clair states the following:

**NATURE OF THE ACTION**

1. In response to the allegations in paragraph 1, St. Clair admits that Apple purports to seek a declaratory judgment of non-infringement and invalidity of the patents-in-suit. St. Clair

admits that Apple purports to bring its counterclaims pursuant to Rule 13 of the Federal Rules of Civil Procedure. St. Clair denies that the patents-in-suit are invalid and not infringed. St. Clair denies any remaining allegations, express or implied.

### **PARTIES**

2. In response to the allegations in paragraph 2, upon information and belief, St. Clair admits that Apple is a California corporation having its principal place of business at One Infinite Loop, Cupertino, California 95014.

3. St. Clair admits the allegation in paragraph 3.

### **JURISDICTION AND VENUE**

4. In response to paragraph 4, St. Clair admits that Apple purports to bring its counterclaims under the United States patent laws, 35 U.S.C. § 1, et seq., and purports that this Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1338, 1367, 2201, and 2202. St. Clair denies that Apple is entitled to any relief. St. Clair denies any remaining allegations, express or implied.

5. St. Clair denies the allegation in paragraph 5.

6. St. Clair admits that it sued Apple for patent infringement of U.S. Patent Nos. 5,138,459; 6,094,219; 6,233,010; and 6,323,899. St. Clair admits that there is an actual controversy between Plaintiff and Apple. St. Clair denies that Apple is entitled to any relief. St. Clair denies any remaining allegations, express or implied.

7. St. Clair admits the allegation in paragraph 7.

**FIRST COUNTERCLAIM<sup>1</sup>**

**(DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF PATENTS-IN-SUIT)**

8. St. Clair admits that in paragraph 8, Apple repeats and realleges each allegation set forth in paragraphs 1 through 7. St. Clair denies any allegation not expressly admitted.

9. St. Clair denies the allegation in paragraph 9.

10. St. Clair denies the allegation in paragraph 10.

**SECOND COUNTERCLAIM**

**(DECLARATORY JUDGMENT OF INVALIDITY OF PATENTS-IN-SUIT)**

11. St. Clair admits that in paragraph 11, Apple repeats and realleges each allegation set forth in paragraphs 1 through 10. St. Clair denies any allegation not expressly admitted.

12. St. Clair denies the allegation of paragraph 12.

13. St. Clair denies the allegation of paragraph 13.

**RESERVATION OF ADDITIONAL COUNTERCLAIMS**

14. St. Clair denies that Apple is entitled to amend its Answer and assert additional counterclaims. St. Clair denies any remaining allegations, express or implied.

**RESPONSE TO DEFENDANT'S PRAYER FOR RELIEF**

15. St. Clair denies that Apple is entitled to any relief whatsoever in this action, either as prayed for on St. Clair's claims or on Apple's Counterclaims or otherwise.

**AFFIRMATIVE DEFENSES**

16. Apple's Counterclaims fail to state a claim upon which relief can be granted.

17. St. Clair hereby reserves all affirmative defenses under Rule 8(c) of the Federal Rules of Civil Procedure, the Patent Laws of the United States and any other defense, at law or in

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<sup>1</sup> The headings in the Counterclaims are reproduced herein solely for the convenience of the reader. To the extent such headings include or infer allegations, they are hereby denied.

equity, which may now exist or in the future may be available based on discovery and further actual investigation in this case.

**DEMAND FOR A JURY TRIAL**

St. Clair hereby requests a trial by jury, pursuant to Rule 38 of the Federal Rules of Civil Procedure, on all issues so triable.

**PRAYER FOR RELIEF**

WHEREFORE, St. Clair denies that Apple is entitled to any relief for its Counterclaims and prays for judgment in its favor as prayed for in its First Amended Complaint and against Apple as follows:

- A. Dismissing Apple's Counterclaims with prejudice on the merits;
- B. Awarding St. Clair its costs, disbursements, and attorney's fees incurred in connection with the Counterclaims; and
- C. Awarding St. Clair such other and further relief as the Court deems just, equitable and proper.

Dated: April 9, 2010.

*/s/ Patricia P. McGonigle*

*Of Counsel:*

Ronald J. Schutz, Esq.  
Jake M. Holdreith, Esq.  
Becky R. Thorson, Esq.  
Carrie M. Lambert, Esq.  
Annie Huang, Esq.  
Seth A. Northrop, Esq.  
ROBINS, KAPLAN, MILLER  
& CIRESI L.L.P.  
2800 LaSalle Plaza  
800 LaSalle Avenue  
Minneapolis, MN 55402  
(612) 349-8500

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George H. Seitz, III, Esq. (No. 667)  
gseitz@svglaw.com  
Patricia P. McGonigle, Esq. (No. 3126)  
pmcgonigle@svglaw.com  
SEITZ, VAN OGTROP & GREEN  
222 Delaware Avenue, Suite 1500  
P.O. Box 68  
Wilmington, DE 19899  
(302) 888-0600

**ATTORNEYS FOR PLAINTIFF  
ST. CLAIR INTELLECTUAL PROPERTY  
CONSULTANTS, INC.**

**CERTIFICATE OF SERVICE**

I, Patricia P. McGonigle, Esquire, hereby certify that on this 9th day of April, 2010, I electronically filed the foregoing document with the Clerk of Court using CM/ECF which will send notification of such filing to counsel of record.

*/s/ Patricia P. McGonigle*

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Patricia P. McGonigle (ID No. 3126)  
[pmcgonigle@svglaw.com](mailto:pmcgonigle@svglaw.com)